

REMARKS

After entry of this amendment, claims 45-51 will be pending. Claims 26-44 are canceled without prejudice or disclaimer. Applicants expressly reserve the right to pursue any or all of the canceled claims (e.g., claims 1-44) in one or more continuations or divisionals hereof.

Claims 45-51 are added. Support for the new claims can be found, *inter alia*, at paragraphs [0031], [0035], [0039], [0041], and [0062]-[0064] of the specification and in Figs. 1, 3, and 4. No new matter is introduced.

Applicants have reviewed the Office action including the Examiner's remarks and the reference cited therein. Applicants submit that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited reference.

Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 26-31, 34-37, and 40-44 under 35 U.S.C. § 102 as anticipated by United States patent no. 6,277,108 ("McBroom"). Applicants submit that this rejection is moot in view of the cancellation of the rejected claims.

Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 32, 33, 38, and 39 under 35 U.S.C. § 103 as obvious over McBroom. Applicants submit that this rejection is moot in view of the cancellation of the rejected claims.

Remarks on Newly Introduced Claims

The Newly Introduced Claims are Novel

To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that McBroom does not meet this standard with respect to the newly introduced claims.

Claim 45 recites a radiopaque marker including "a first marker segment abutting the sheath body and extending around a first portion of a perimeter of the sheath body; and a second marker segment abutting the sheath body and extending around a second portion of the perimeter of the sheath body, wherein the first marker segment and the second marker segment are discrete and define a first gap and a second gap therebetween about the perimeter of the sheath body." McBroom does not teach or suggest the claimed discrete marker segments. Thus, McBroom cannot anticipate claim 45. Claims 46-48 depend from claim 45 and are not anticipated by McBroom for at least the same reason.

Claim 50 recites that "the distal end of the sheath body is separated into an inner ring and an outer ring via a longitudinal cut around its perimeter, and ... the contiguous radiopaque ring is sealed inside the distal end of the sheath body between the inner ring and the outer ring." McBroom neither teaches nor suggests this arrangement, and accordingly fails to anticipate claim 50.

Claim 51 recites that "the inner surface of the tubular body [of the radiopaque ring] is formed in a funnel shape at a proximal end thereof." McBroom makes no suggestion of the claimed funnel shape. It follows that McBroom does not anticipate claim 51.

For at least the foregoing reasons, Applicants respectfully submit that the newly introduced claims are novel over McBroom.

The Newly Introduced Claims are Non-Obvious

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicants contend that the differences between the newly introduced claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. MPEP § 2141 ("[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on *what such a person would have reasonably expected to have been able to do in view of that knowledge.*") (emphasis

added). In particular, because McBroom fails to teach or suggest each and every element of the newly introduced claims, as discussed above, Applicants respectfully submit that one of ordinary skill in the art would not have learned the claimed invention from the combination of McBroom. The previously-cited Norlander reference (United States patent no. 6,562,049) likewise fails to teach or suggest at least the same aspects of the invention lacking in McBroom. Accordingly, Applicants contend that the claimed invention is substantially different from, and therefore not obvious over, McBroom and Norlander, whether considered alone or in combination.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should any extension of time be deemed necessary, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees, including fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-044600US/82410-0054.

Respectfully submitted,

WILEY REIN LLP

Date: February 17, 2009

By: /Scott A. Felder #47558/
Scott A. Felder
Registration No. 47,558

WILEY REIN LLP
Attn: Patent Administration
1776 K Street, N.W.
Washington, D.C. 20006
Telephone: 202.719.7000
Facsimile: 202.719.7049